

REMARKS

I. GENERAL

Claims 1-26 are pending. The outstanding issues in the Final Office Action are:

- Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* (U.S. Patent No. 6,6061,697) in view of *Brown* (U.S. Pub. No. 2004/0177321); and
- Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*, and further in view of *Judson* (U.S. Patent No., 5752,643).

Applicant respectfully traverses these rejections, and requests reconsideration and withdrawal in light of the remarks contained herein.

II. AMENDMENTS

Applicant amended claims 2 and 16 to correct typographical errors in each such claim. Claims 2 and 16 each ended with a semi-colon instead of a period. Applicant amended the claims to add the period at the end of the claims. No new matter was added.

Claim 1 was amended to read, “restricting edit functions of a page editor editing said revised document, wherein said restricting is responsive to said page editor reading said one or more restriction tags.” Claim 8 was amended to read, “code for prohibiting edit functions of a document editor editing said modified document, wherein said code for prohibiting is executed responsive to said prohibition labels.” Claim 15 was amended to read, “restricting edit functions of a Web editor editing said substitute Web document, wherein said restricting is responsive to said one or more restriction markup tags.” Support for these amendments can be found throughout the Specification, particularly at paragraphs [0010] – [0011], [0025] – [0026], and [0028]. No new matter was added.

III. REJECTIONS UNDER 35 U.S.C. § 103(a) OVER *NAKAO* IN VIEW OF *BROWN*

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*. Final Office Action at page 2. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicant asserts that the rejection does not satisfy the basic criteria.

A. *Lack of All Claimed Limitations*

Claim 1 recites, in part, "identifying a plurality of tags" Claims 8, 15, and 22 recite similar limitations. For example, claim 8 requires, "code for parsing said multi-formatted document, wherein said each of said multiple formats is delimited in said multi-formatted document by one or more descriptive labels." Claim 15 requires, "parsing said Web document; analyzing a plurality of markup tags within said Web document." Claim 22 requires, "a parsing engine for analyzing a plurality of Web page markup tags." The Examiner relies solely upon *Nakao* as meeting these limitations. Final Office Action at page 2. More specifically, the Examiner contends that "[b]ecause *Nakao* teaches that each element, i.e., tag, of a document [is] assigned an instance identifier, *Nakao* teaches identifying a plurality of tags." Final Office Action at page 11. However, Applicant respectfully asserts that the term "document elements," as used by *Nakao*, does not refer to "tags." Rather, several passages of *Nakao* describe "document elements" as portions of a document that are subject to being edited. For example, *Nakao* discloses that:

[t]he conventional SGML document managing apparatus uses the check-out/check-in system of *document elements*. It checks out a *document element* according to the request for editing from a worker, and allows the worker to update only the

portion in lower hierarchical levels than the checked-out element. When the portion is checked in, it examines the conformance to the DTD of the entire document to maintain the consistency of the document (this operation is referred to as SGML parsing). *Nakao* at col. 2, lines 20-29 (emphasis added).

Thus, although *Nakao* may teach assigning an instance identifier to a document element, it does not meet the step of “identifying a plurality of tags,” as recited in claim 1, because a “document element,” as defined and used in *Nakao*, is not a “tag.” Applicant respectfully reminds the Examiner that *Nakao* was entitled to be his own lexicographer. See M.P.E.P. § 2111.01. Because a definition was provided by *Nakao* for the term “document element,” that definition controls interpretation of that term. *Id.*

The Examiner further contends that “[i]t was notoriously well known in the art at the time of the invention that a SGML element was also known as a ‘tag.’” Final Office Action at page 11. However, contrary to the Examiner’s position, “elements” are not “tags.” In fact, the difference between tags and elements is basic:

[b]ecause this *basic concept* is so important to understand, I think it bears repeating: *tags* are the letters and numbers between the angle brackets, whereas *elements* are tags *and* anything between the opening and closing tags. JOHN DUCKETT, BEGINNING WEB PROGRAMMING WITH HTML, XHTML, AND CSS 6 (Wiley Publishing, Inc. 2004) (emphasis added).

Thus, an element is not the same thing as a tag, as suggested by the Examiner. Moreover, even assuming that *Nakao*’s document element may contain a plurality of tags, identifying a document element is not the same as identifying tags within that document element. Applicant has been unable to find any disclosure in *Brown* that teaches or suggests the aforementioned step, and the Examiner has not shown otherwise. Therefore, the combination of *Nakao* and *Brown* does not teach or suggest every limitation of claim 1. Similarly, this combination of references does not teach or suggest every limitation of claims 8, 15, and 22. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claims 1, 8, 15, and 22.

Claim 1 also recites, in part, “inserting one or more restriction tags into said revised document” Claims 8, 15, and 22 recite similar limitations. For example, claim 8 requires, “code for inserting a prohibition label in said modified document around each instance of non-editable content as defined by said one or more descriptive labels.” Claim 15 requires, “inserting one or more restriction markup tags in said substitute Web document demarcating non-editable content as defined by one or more of said plurality of markup tags.” Claim 22 requires, “a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags.” The Examiner admits that *Nakao* does not teach or suggest such limitations, and relies solely upon *Brown* as meeting these limitations. Final Office Action at page 3. According to *Brown*, an “input XML file” is bounded by a “bounding file,” where the bounding file specifies restrictions for editing the input XML file. *Brown* at paragraph [0060], [0094]. *Brown* teaches the use of two different files for providing its restrictive features. It uses the bounding file to get the restrictions that will be used when the XML file is to be edited. The claimed invention, as claimed in claims 1, 8, and 15 each teach inserting the restriction tags into the revised document where it is that revised document that is to be restrictively edited. Moreover, claim 22 teaches using a Web page and not a second file to go along with the Web page. Thus, *Brown*’s bounding file is not the document to be revised (i.e., “the input XML file”) nor is its use of two files the same as the two files described in claims 1, 8, and 15. See *Brown* at paragraphs [0094]-[0102].

At the passage cited by the Examiner, *Brown* discloses inserting restrictions into the bounding file, not the input XML file. *Brown* at paragraph [0107]. As such, although *Brown* may teach inserting a restriction into a bounding file, that does not meet the step of “inserting one or more restriction tags into [a] revised document,” as recited in claim 1, because a bounding file is not a revised document. Therefore, the combination of *Nakao* and *Brown* does not teach or suggest every limitation of claim 1. Similarly, this combination of references does not teach or suggest every limitation of claims 8, 15, and 22. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claims 1, 8, 15, and 22.

Claim 1, as amended, further recites, in part, “restricting edit functions of a page editor editing said revised document, wherein said restricting is responsive to said page editor reading said one or more restriction tags.” Claims 8, 15, and 22 recite similar limitations. For example, claim 8, as amended, requires, “code for prohibiting edit functions of a document editor editing said modified document, wherein said code for prohibiting is executed responsive to said prohibition labels.” Claim 15, as amended, requires, “restricting edit functions of a page editor editing said revised document, wherein said restricting is responsive to said page editor reading said one or more restriction tags.” Claim 22 requires, “a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags.” The Examiner has alleged that *Nakao*’s claim 14 teaches these limitations. Final Office Action at page 3. However, *Nakao*’s claim 14 only provides for an “editing consistency examining means for determining whether or not an edited result of said editing means is consistent with the entire document corresponding to the partial editing restriction information.” *Nakao* at col. 35, lines 41-45. *Nakao*’s claim 14 does not describe restricting edit functions of a page editor when editing the revised document. There is no description in *Nakao* that teaches or even suggests restricting edit functions of a page editor, as required by claim 1.

The Examiner also relies upon *Brown* as teaching or suggesting the aforementioned step of claim 1. Final Office Action at page 12. However, at the passage cited by the Examiner, *Brown* only discloses a meta editor that allows a developer to select an element in a bounding file to be hidden or non-editable when it has a particular value. *Brown* at paragraph [0108]. As such, while *Brown*’s restrictions may be responsive to a developer’s selection, they are not responsive to the reading of a restriction tag. Moreover, as noted above, because *Brown*’s bounding file is not a revised document, *Brown* does not restrict editing by reading tags which are placed in a revised document, as claimed. Therefore, the combination of *Nakao* and *Brown* does not teach or suggest every limitation of claim 1. Similarly, this combination of references does not teach or suggest every limitation of claims 8, 15, and 22. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claims 1, 8, 15, and 22.

Dependent claims 2-7 depend either directly or indirectly from claim 1, and thus inherit all the limitations of that independent claim. Dependent claims 9-14 depend either directly or indirectly from claim 8, and thus inherit all the limitations of that independent claim. Dependent claims 16-21 depend either directly or indirectly from claim 15, and thus inherit all the limitations of that independent claim. Dependent claims 23-26 depend either directly or indirectly from claim 22, and thus inherit all the limitations of that independent claim. As noted above, the combination of *Nakao* and *Brown* fails to teach or suggest all of the limitations of independent claims 1, 8, 15, and 22. Consequently, the combination of *Nakao* and *Brown* also fails to teach or suggest all of the limitations of dependent claims 2-7, 9-14, 16-21, and 23-26. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claims 2-7, 9-14, 16-21, and 23-26.

B. Improper Motivation

Applicant further asserts that, in addition to the fact that the combination of *Brown* with *Nakao* does not teach or even suggest all of the claimed limitations, there is no suggestion or motivation to combine these references. The Examiner states that:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to apply Brown to Nakao, so that the user would have the benefit of techniques that enable application developers to have some control over what users can do when editing a structured document file. Final Office Action at page 3.

However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art or its teachings also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. Furthermore, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result (i.e., “it would have been obvious to combine *Brown* with *Nakao* in order to have features of *Brown* combined with *Nakao*’s”). Such language is merely a statement that the references can be combined and does not state any desirability for making the combination. Neither the prior

art nor the knowledge available to a person of ordinary skill in the art at the time the invention was made suggest the desirability of the combination, and Applicant asserts that there is no suggestion or motivation to combine *Brown* with *Nakao*. Therefore, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103(a). *See* M.P.E.P. § 2143. Moreover, Applicant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure. *See* M.P.E.P. § 2145(X)(A). Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 1-26.

IV. REJECTION UNDER 35 U.S.C. § 103(a) OVER *NAKAO* IN VIEW OF *BROWN* AND *JUDSON*

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown* and *Judson*. Final Office Action at page 10. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

As noted above, in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicant asserts that the rejection does not satisfy the basic criteria.

A. *Lack of All Claimed Limitations*

The combination of *Nakao* and *Brown* fails to teach or suggest several features required by independent claim 22. Specifically, the combination of *Nakao* and *Brown* fail to teach or suggest "a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags;" "a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags;" and "a parsing engine for analyzing a plurality of Web page markup tags." The Examiner does not

rely upon *Judson* as teaching or suggesting these features with regard to claim 22, and Applicant asserts that *Judson* does not teach or suggest the above-referenced feature. Therefore, the combination of *Nakao*, *Brown*, and *Judson* fails to teach or suggest all of the limitations of independent claim 22. Dependent claim 25 depend from claim 22, and thus inherit all the limitations of that independent claim. Consequently, the combination of *Nakao*, *Brown*, and *Judson* also fails to teach or suggest all of the limitations of dependent claim 25. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claim 25.

B. Improper Motivation

The Examiner has not attempted to put forth any motivation for the combination of *Nakao*, *Brown*, and *Judson*. See Final Office Action at page 10. Applicant can find no such motivation. “When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986), cited in M.P.E.P. § 2142. Applicant asserts that there is no suggestion or motivation, either in the prior art or the knowledge available to a person of ordinary skill in the art, to combine *Nakao* with *Brown* and *Judson*. In fact, the Examiner again seems to be relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure. See M.P.E.P. § 2145(X)(A). Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 25.

V. CONCLUSION

In view of the above remarks, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 47583/P041US/10311286 from which the undersigned is authorized to draw.

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